

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Mark D. Scott, et al.

Examiner: R. Hayes

Serial No. 09/323,765

Group Art Unit: 1647

Filed: June 1, 1999

Docket No. 259.006US1

Title: ANTIGENIC MODULATION OF CELLS

**OFFICE OF PETITIONS  
MAIL STOP PETITIONS  
P.O. BOX 1450  
COMMISSIONER FOR PATENTS  
Alexandria, VA 22313-145**

**PETITION TO REVIVE AN UNINTENTIONAL ABANDONMENT  
UNDER 37 CFR 1.137(b)**

Attention:  
Paralegal Specialist  
Office of Petitions  
MAIL STOP PETITIONS  
P.O. BOX 1450  
COMMISSIONER FOR PATENTS  
Alexandria, VA 22313-145

Dear Sir/Madam:

**FACTUAL BACKGROUND**

1) A notice on form PTO-90C was mailed by the U.S. Patent and Trademark Office on January 24, 2003, dismissing the Appeal. It is asserted that this Appeal was untimely dismissed as any difficulty in attempting to respond to the original statement from the PTO mailed on August 29, 2002 (asserting a Non-Compliant Brief) was due at least in part to the lack of clarity as to reasons for failure in compliance of the Brief under 37 CFR 1.192(c).

2) Attorney for Applicant signed the transmittal documents for the Supplemental Brief on Appeal on 23 September 2003, and provided a transmittal cover sheet for transmittal of the documents, authorized payment of the necessary fees in a separate document, and included a return postcard identifying all of these documents.

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01 FC:2453 750.00 DA

- 3) All documents described in paragraph 2) above were mailed with a certification of mailing under 37 C.F.R. 1.8 with a mailing date of 23 September 2003.
- 4) The return postcard was returned to Attorney for Applicants with a date of receipt in the U.S. Patent and Trademark Office of September 30, 2002 which date is consistent with the mailing date of mailing of the documents identified in paragraph 2..
- 5) On 24 January 2003, the U.S. Patent and Trademark Office mailed a PTO-90C form on the Application, indicating that Applicant failed to file a Brief in compliance with the original Notice of Non-Compliance.
- 6) As the documents included with this Petition clearly shows that all formalities for Brief on Appeal of this Application were timely performed *in good faith* by Attorney for Applicants and timely received by the U.S. Patent and Trademark Office, the Abandonment of this Application is clearly in error, was inadvertent and/or unintentional, **and was the result of error on the part of the U.S. Patent and Trademark Office, with no error or responsibility by Applicants or their counsel. AT A MINIMUM, APPLICANTS, ACCORDING TO STANDARD PRACTICE OF THE U.S.P.T.O. SHOULD HAVE BEEN GRANTED TIME TO CORRECT DEFICIENCIES.**
- 7) **DECISION ON PETITION WAS ISSUED ON MAY 25, 2007 DISMISSING THE EARLIER PETITION FILED 28 AUGUST 2006/**

**APPLICANTS HERE ATTEMPT TO SHOW THAT IN ACCORDANCE WITH THE STATEMENTS IN THE DECISION ON PETITION, THE PRESENT PETITION SHOULD BE GRANTED.**

The Decision on Petition states that a Grantable Petition under 37 C.F.R. 1.137(b) must contain:

- 1) The required reply under 1.137(b).
- 2) The Petition set forth in 37 C.F.R. 1.17(m);
- 3) a statement that the entire delay in filing the required replay from the due date for the replay until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and

4) any Terminal Disclaimer (and fee) set forth in 37 C.F.R. 1.20(d) required by 37 C.F.R. 1.137(d).

#### **CONTENT OF THIS PETITION AND ATTACHMENTS**

**1) The required reply with all necessary materials was submitted with the Petition on August 23, 2006. A duplicate copy of that Brief is attached hereto and resubmitted with this Petition.**

**2) The Petition set forth in 37 C.F.R. 1.17(m)**

**The present document constitutes the Petition set forth in 37 C.F.R. 1.17(m) and the Attorney of Record hereby authorizes debiting of Attorney's deposit Account No. 501391 for the fees at a rate for a SMALL ENTITY (\$750.00), which the assignee is,**

(m) For filing a petition for the revival of an unintentionally abandoned application, for the unintentionally delayed payment of the fee for issuing a patent, or for the revival of an unintentionally terminated reexamination proceeding under 35 U.S.C. 41(a)(7) (§1.137(b):

By a small entity (§1.27(a): \$750.00

**3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional;**

**The attorney of record hereby states and declares, with full knowledge and acceptance of the legal penalties for intentional misstatements before the US Patent and Trademark Office that the entire delay in filing the required reply until the filing of the grantable petition pursuant to 37 C.F.R. 1.137(d) was unintentional.**

1) As a first point of evidence, whether the Attorney of record has made technical errors in the provision of documents in filing the Brief and the Replacement Briefs and Petitions, the attorney of record has made good faith efforts at filing the appropriate documents, and, since the original Brief Filing, has not billed clients, accepting responsibility for the work without payment. Each and every response has been filed by the Attorney of record.

2) As a second point of reference, even though there was an error in the Replacement Brief(s) and in the previous Petition, the Attorney of Record unintentionally misunderstood the complete nature of the failure in the original Replacement Brief. This mistake was unintentional.

3) Although the Attorney of record must accept responsibility for the error in the earlier replacement brief, any error were complicated by and contributed to by the misunderstanding of one issue (the citation of the and the continued mis-citation of the Lin reference that is the basis of the holding of lack of response.

a) The rejection by the Patent Office and the statement of the Non-Compliance of the Brief repeatedly referred to the Lin (1976) reference, when no such reference exists of record.

b) **NOTE:** There is no Lin et al. reference (1976). The actual Lin et al. reference of record, cited and provided on June 3, 2004 (Not June 1, 2004 as indicated) is Lin and Riggs, "Photochemical Attachment of *lac* Repressor to Bromodeoxyuridine-Substituted *lac* Operator by Ultraviolet Radiation," *Proc. Nat. Acad. Sci.* Vol. **71**, No. 3, pp. 947-951, March 1974 (with a communication date of October 27, 1973). The reference to Lin et al. (1976) having been confusing and misleading.

c) Appellants have completely responded to the citation of the Lin et al, (1974) reference in the present replacement Brief, and it is to be noted that this reference is at best marginally relevant, if not immaterial to the substance of the rejection, as noted in the Brief.

4) Any deficiencies in the response and the Petition were always unintentional. The fact that the Attorney of Record has persisted in attempting to reach an appeal, with no additional billings to the client. AS evidence of this fact, the Attorney of Record attached hereto the last billing invoice to the client (Biomedical Frontiers, the licensee of the present application) showing that the entire cost for the replacement Brief and Petition to revive (see the billing date of August 31, 2006) was removed from the balance sheet as "Never Paid."

5) The Attorney of Record also states of record, that no further billing entrees have been made or will be made on this Application for the present petition and filing of a Replacement Brief.

6) Appellant attached hereto also, the relevant page (Page 5) of the Final Rejection with the mis-citation of the Lin et al. reference by the PTO highlighted.

7) The Attorney of Record feels that the unintentional delay in filing a Brief on Appeal was due to the fact that the Attorney of Record was distracted by repeated efforts of record to avoid preparation of an Examiner's Answer, such as by earlier efforts by the Examiner to hold the case abandoned for not filing "evidence" in the Evidence Appendix Page consisting of references cited and supplied by the Patent and Trademark Office. The Attorney of Record admits to being distracted by the repeated and constant barrage of incidental attacks on form and style raised in the prosecution history. However, this distractions were unintentional and led to the unintentional filing of a Brief that did not respond to one of the many efforts made and issues raised to avoid a decision on the merits.

8) The attorney of Record has repeatedly made a good faith effort to comply with every request and identified issue in the prosecution of this application. The continued response to issues, even if containing the last time, a single unintentional error, shows that any delay in filing a correct Brief on Appeal were unintentional. The attorney of record would have no benefit in failing to file a correct Brief on Appeal and the repeated effort shows that any delay was unintentional.

**4) any Terminal Disclaimer (and fee) set forth in 37 C.F.R. 1.20(d) required by 37 C.F.R. 1.137(d).**

Accompanying this Petition is a Terminal Disclaimer, Plus authorization for debiting of the fee for a small entity for the fees for this Terminal Disclaimer in accordance with 37 C.F.R. §1.137(b)

*"...(d) Terminal disclaimer.*

(1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in §1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application."

8) APPLICANTS herewith submit three copies of what is believed to be a corrected Brief on Appeal and an outline of why the Examiner's position was in error.

## PETITION

1) Appellants Petition as follows:

Applicants hereby petition to revive the application due to the fact that any failure or delay in compliance was unintentional. The abandonment of the application was unintentional and/or inadvertent

The contact person is invited to telephone Applicant's attorney (952) 832-9090 if necessary. **If necessary please charge any additional fees to Deposit Account No. 50-1391 for the petition for revive unintentional abandonment under 37 CFR 1.137(b).**

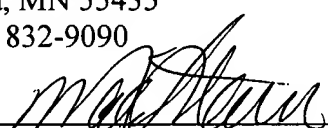
Respectfully submitted,

Mark D. Scott et al.

By their Representatives,

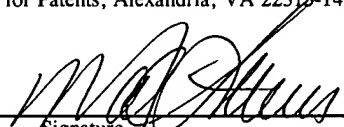
Mark A. Litman & Associates, P.A.  
York Business Center, Suite 205  
3209 West 76<sup>th</sup> Street  
Edina, MN 55435  
(952) 832-9090

Date: AUGUST 25, 2007

By   
Mark A. Litman  
Reg. No. 26,390  
(952) 932-9090

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to MAIL STOP PETITION, P.O. BOX 1450, Commissioner for Patents, Alexandria, VA 22312-1450 on 25 AUGUST 2007.

Mark A. Litman  
Name

  
Signature



6. Claim 28 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reasons made of record in Paper No. 13 (mailed 4/10/01) & 16 (mailed 10/03/01), and as follows.

Claim 28 still recites "the method of claim 21", wherein claim 21 alternatively is directed to a "cellular composition" (i.e., a product, and not a "method" as currently claimed).

It is suggested that amending claim 28 to "the cellular composition [method] of claim 21" should obviate this rejection.

7. Claims 2-7, 18-21, 22-25, 28 & 31 stand rejected under 35 U.S.C. 102(e) as being anticipated by Desai et al. (U.S. Patent 5,578,442), *in light of* ~~Lin et al. (1976)~~ for the reasons made of record in Paper No. 13 (mailed 4/10/01), 16 (mailed 10/03/01) & 20040601, and as follows.

In contrast to Applicants' assertions on pages 19-20 & 22-26 of the response, and as previously made of record, Desai clearly teach "covalent bonding" through, for example, free radical polymerization (i.e., col. 4, lines 40-54; col. 5, lines 13-26), **and through UV-crosslinking** (e.g., col. 3, lines 57-61), and as supported by Desai's statement that "[i]n addition, *the further crosslinking of the graft polymer forms a highly stabilized* [i.e., covalent binding], immuno-protective coating of water-soluble [i.e., hydrophilic, by definition] polymer about the treated cell or tissue" [emphasis added], therefore at antigenic sites present in all membrane-bounded proteins, by definition (column 3, lines 53-56). As support that it is well known in the

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Invoice submitted to:  
Bo Hedlund  
Biomedical Frontiers, Inc.  
1095 10th Avenue Southeast  
Minneapolis MN 55414

October 02, 2006

	<u>Amount</u>
Previous balance	\$5,905.00
8/31/2006 Payment - thank you. Check No. Never Paid	<u>(\$5,905.00)</u>
Total payments and adjustments	<u>(\$5,905.00)</u>
Balance due	<u><u>\$0.00</u></u>